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PATENT
Docket No. 10426US01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

YUNG YIP

Serial No.: 10/755,143

Filed: January 8, 2004

For: SYSTEM WITH MATRIX ARRAY OF
WRITE HEADS AND ARRAY OF
MAGNETORESISTIVE (MR)
READ HEADS

Examiner: Angel A. Castro

Group Art Unit: 2627

CERTIFICATE OF TELEFACSIMILE TRANSMISSIONMail Stop: **Petitions**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450Examiner Angel A. Castro
Fax No.: (671) 273-8300

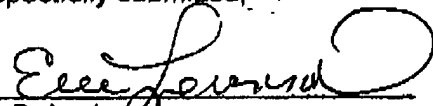
Dear Sir:

I certify that the following pages are being telefacsimile transmitted to the U.S. Patent and Trademark Office on the date shown below:

1. Petition to the Director under 37 CFR 1.181, including Certificate of Facsimile (4 pages)

Respectfully submitted,

Date

12/17/07
Eric D. Levinson
Reg. No. 35,814Imation Legal Affairs
P.O. Box 64898
St. Paul, Minnesota 55164-0898
Telephone: (651) 704-3604
Facsimile: (651) 704-5951**5 PAGES - INCLUDING COVER PAGE**

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DEC 17 2007

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Yung Yip	Confirmation No.	9649
Serial No.:	10/755,143		
Filed:	January 8, 2004	Customer No.:	30590
Examiner:	Angel A. Castro		
Group Art Unit:	2627		
Docket No.:	10426US01		
Title:	SYSTEM WITH MATRIX ARRAY OF WRITE HEADS AND ARRAY OF MAGNETORESISTIVE (MR) READ HEADS		

CERTIFICATE UNDER 37 CFR 1.8: I hereby certify that this correspondence is being transmitted by facsimile to the
Commissioner for Patents, Alexandria, VA 22313-1450 on Dec 17 2007.

By:

Name: Eric D. Levinson

PETITION TO THE DIRECTOR UNDER 37 CFR §1.181**Mail Stop: Petitions**Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

Applicant hereby petitions the Director of the United States Patent and Trademark Office under 37 CFR §1.181. Applicant requests that the Director:

- 1) reinstate withdrawn claims 21 and 22, which were withdrawn by the Examiner in the final Office Action mailed October 19, 2007 based on an improper Election Requirement, and
- 2) rescind the finality of the final Office Action mailed October 19, 2007.

The Examiner improperly refused to examine claims 21 and 22, and has failed to address Applicant's arguments as to why claims 21 and 22 are not a species relative to the genus of claim 1. The finality of the current Office Action is also improper for this reason.

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In failing to address Applicant's arguments regarding the fact that claims 21 and 22 are an elected species, the Examiner has simply stated that:

[T]here are 3 different species (not a common genus) as specified in the Office Action mailed 8/11/06. It was also specified that if claims are added after the election, applicant must indicate which are readable upon the elected species, in the present case claims 21-22 are not readable on the elected species.

This statement fails to address Applicant's arguments on the issue. Applicant's argument has been presented several times, but has still not been addressed by the Examiner in any substantive fashion. Rather, the Examiner is simply advancing a conclusion that claims 21 and 22 are not a species relative to the genus of claim 1 without explaining how or why.

Applicant has explained why claims 21 and 22 are readable on Applicant's elected species. The Examiner, not Applicant, has failed to meet the burden of proof in responding to Applicant's arguments (which have been presented several times) that claims 21 and 22 are directed to an elected species. The procedural posture of claims 21 and 22 is explained below.

In the Office Action mailed on 8/11/2006, the Examiner advanced an Election of Species Requirement, indicating that FIGS. 2, 6 and 8 illustrate patentably distinct species. In response to the Election of Species Requirement, Applicant explained that FIG. 2 (claim 1) is generic relative to FIG. 6 (former claim 13) and FIG. 8 (former claim 18). Applicant agreed with the Examiner that FIG. 6 (former claim 13) and FIG. 8 (former claim 18) are species of a common genus shown in FIG. 2 (claim 1). On this basis, Applicant elected the genus shown in FIG. 2 (claim 1), and further elected the species shown in FIG. 6 (claim 13) over the species shown in FIG. 8 (claim 18).

In response to Applicant's election and argument that FIG. 2 (claim 1) is generic relative to FIG. 6 (former claim 13) and FIG. 8 (former claim 18), the Examiner withdrew both of former claims 13 and 18 (by withdrawing claims 13-20 from consideration). At that time, the Examiner failed to address Applicant's arguments, or specifically explain why the Examiner thinks that FIG. 2 (claim 1), FIG. 6 (former claim 13), and FIG. 8 (former claim 18) show three different species. Applicant's position has consistently been that, contrary to the Examiner's statements, FIG. 2 (claim 1) is generic relative to FIG. 6 (former claim 13) and FIG. 8 (former claim 18). Applicant is still waiting for an explanation of why the Examiner thinks that FIG. 2 (claim 1), FIG. 6 (former claim 13), and FIG. 8 (former claim 18) show three different species.

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After the Examiner withdrew claims 13 and 18, Applicant immediately added claims 21 and 22 to the application and explained that claim 21 is similar to former claim 13. At this point, Applicant again explained that FIG. 2 (claim 1) is generic relative to FIG. 6 (former claim 13 and present claim 21) and FIG. 8 (former claim 18).

Now, in response to Applicant's argument on this issue, the Examiner issued a final Office Action, which simply refers back to the Election of Species Requirement mailed on 8/11/2006. However, Applicant traversed the Election of Species Requirement mailed on 8/11/2006, and the Examiner has still failed to address Applicant's arguments as to why the Election of Species Requirement mailed on 8/11/2006 was improper in the first place.

Specifically, the Examiner has still failed to explain why the Examiner thinks that FIG. 2 (claim 1), FIG. 6 (former claim 13 and present claim 21), and FIG. 8 (former claim 18) show three different species. Again, Applicant's position has consistently been that, contrary to the Examiner's statements, FIG. 2 (claim 1) is generic relative to FIG. 6 (former claim 13 and present claim 21) and FIG. 8 (former claim 18). Applicant is still waiting for an explanation of why the Examiner thinks that FIG. 2 (claim 1), FIG. 6 (former claim 13 and present claim 21), and FIG. 8 (former claim 18) show three different species.

Applicant again notes that while the presence of a generic claim is not, by itself, a basis for obviating an election of species, the fact that claim 1 is generic relative to claim 21 precludes claims 1 and 21 from being different species of a common genus. Therefore, any need to elect between claim 1 and 21 (or claim 1 and former claim 13) was improper at the time of the Election Requirement and remains improper in the current case. The genus is defined by claim 1, and claim 21 defines a species within this common genus of claim 1. Therefore, claims 1 and 21 should be examined together, consistent with Applicant's election of the genus of FIG. 2 and the species of FIG. 6.

The Examiner's previous statement that the presence of a generic claim is not a basis for obviating an election of species applies only with respect to election between the species formerly defined by claims 13 and 18. In this case, the presence of generic claim 1 is not a basis for obviating an election of species between claims 13 and 18. However, Applicant elected claim 13 over claim 18. The fact that claim 1 is generic with respect to claims 13 and 18 precludes the Examiner from withdrawing examination of the subject matter of both claims 13 and 18. The

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Examiner should have examined claim 13 in the first Office Action, and should have examined claims 21 and 22 in the current Office Action.

With respect to the Examiner's previous statement that Applicant's disclosure indicates that the structure of FIG. 2 is considered a distinct species, Applicant disagrees, and submits that the Examiner has provided no basis for this assertion. Again, claim 1 defines a genus, and claims 13 and 18 were species of the common genus of claim 1. Applicant is entitled to examination of the genus defined in claim 1 and at least one of the species of that genus, e.g., the species formerly defined in claim 13 and currently recited in claim 21. Nothing in Applicant's disclosure states that the structure of FIG. 2 is considered a distinct species relative to the structure of FIG. 6.

In short, the Examiner cannot, as a matter of law, assert that independent claim 1 and dependent claim 21 (which depends upon claim 1) are species of a common genus. On the contrary, claim 1 is clearly generic with respect to claim 21, and there are no other alternative species to claim 21 that are currently pending. The Examiner's current position appears to be nothing more than an assertion that the Examiner sent the Election Requirement on 8/11/2006. The Examiner has failed to address Applicant's arguments, as outlined above.

In view of these comments and observations, Applicant respectfully requests that the Director reinstate claims 21 and 22 and instruct the Examiner to examine these claims. This will require withdrawal of the finality of the current Office Action, as claims 21 and 22 have not been examined to date, even though Applicant is entitled to such examination.

Please charge any additional fees or credit any overpayment to deposit account number 09-0069. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

12/17/07

Imation Legal Affairs
P.O. Box 64898
St. Paul, Minnesota 55164-0898
Telephone: (651) 704-3604
Facsimile: (651) 704-5951

By:



Name: Eric B. Levinson
Reg. No.: 35,814